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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,189	11/29/1999	HEINRICH ULRICH	016790/0376	1362

7590 07/31/2003

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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/331,189

Applicant(s)

ULRICH ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22, 26-28, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-22 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission (Paper No. 30) filed on May 14, 2003 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendment (Paper No. 31) of May 14, 2003. It is noted that in the mentioned amendment, applicant has canceled claims 42 and 45-46 (Note: Claims 1-15, 23-25, and 29-41 were canceled as indicated in the amendments (Paper No. 5 of 6/24/99; Paper No. 12 of 3/5/01 and Paper No. 27 of 12/6/02). The remaining claims 16-22, 26-28 and 43-44 are examined in this Office action.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 16-18, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al (U.S. Patent No. 4,650,335, of record).

Ito et al disclose a scanning microscope. The microscope as described in columns 2-3 and shown in fig. 1 comprises an observation tube having an ocular,

a laser scanner having a scanning mirror (3), a scanning lens (8), and an image rotating system in the form of a Dove prism (6) wherein the image rotating system is located between the scanning mirror (3) and the scanning lens (8). It is also noted that the system comprises a first objective lens system (7) and a second objective (10) for focusing light into the sample (13) and for guiding light from the sample to a detecting system having a CCD. The use of lens elements (28) in the art of Ito et al as a tube lens for imaging is disclosed, and the claim recites a microscope having an ocular and a tube lens without any specific limitations/features relating to the positions or the functions of the elements in the claim. As a result, all scanning and video images fed through the laser scanner will be rotated by the image rotation system. It is noted that the use of a thick beam splitter can be seen in the element (5) disposed between the image rotating system and the lens (4). With regard to the feature thereof "optics defining a path of rays of a confocal microscope" recited on line 2 of claim 16, such a feature is readable from the elements arranged from the light source (1) to the beam splitter (30) located on the downstream of the lens (8). With regard to the feature concerning the so-called "confocal microscope", such a recitation is readable from the "scanning microscope" provided by Ito et al because the claim has not provided any specific features relating to the elements as well as the structure of the so-called "confocal microscope" to make the device claimed distinct from the art of Ito et al. The support for that conclusion is found in the specification and in particular, the embodiment shown in figure 3 which discloses

the use of a laser scanner having a scanning mirror disposed along the light path from the light source to the scanning lens.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al in view of Wasmund et al (U.S. Patent No. 4,181,436, of record).

See the rejection as set forth in the previous Office action (Paper No. 28, pages 5-6).

7. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S. Patent No. 4,650,335) in view of the Japanese reference No. 8-334698 (of record).

See the rejection as set forth in the previous Office action (Paper No. 28, pages 6-7).

8. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S. Patent No. 4,650,335) in view of Hasegawa (U.S. Patent No. 5,270,855).

See the rejection as set forth in the previous Office action (Paper No. 28, pages 7-8).

Allowable Subject Matter

9. Claims 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. The amendments to the claims 16, 27-28 and the cancellation of claims 42 and 45-46 are sufficient to overcome the rejections of the claims under 35 USC 112.

Regard to the rejections of the claims under 35 USC 102(b) and 35 USC 103(a) over the art, applicant's arguments filed on 5/14/03 (Paper No. 31, pages 5-6) have been fully considered but they are not persuasive.

A) With regard to the rejection of claims under 35 USC 102(b) over the art of Ito et al, applicant has argued that the art of Ito et al does not disclose the feature thereof "optics defining a path of rays of a confocal microscope". The examiner respectfully disagrees with the applicant's opinions and respectfully invited the applicant to review the present claim in the light of the present specification and the art of Ito et al.

First, regarding to the feature thereof "optics defining a path of rays of a confocal microscope" recited on line 2 of claim 16, such a feature is readable from the elements arranged from the light source (1) to the beam splitter (30) located on the downstream of the lens (8). With regard to the feature concerning the so-

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called "confocal microscope", such a recitation is readable from the "scanning microscope" provided by Ito et al because the claim has not provided any specific features relating to the elements as well as the structure of the so-called "confocal microscope" to make the device claimed distinct from the art of Ito et al. The support for that conclusion is found in the specification and in particular, the embodiment shown in figure 3 which discloses the use of a laser scanner having a scanning mirror disposed along the light path from the light source to the scanning lens.

Second, all of the features recited in the claims are clearly disclosed in the art of Ito et al. In particular, the microscope as described in columns 2-3 and shown in fig. 1 comprises an observation tube having an ocular, a laser scanner having a scanning mirror (3), a scanning lens (8), and an image rotating system in the form of a Dove prism (6) wherein the image rotating system is located between the scanning mirror (3) and the scanning lens (8). It is also noted that the system comprises a first objective lens system (7) acts as a tube lens and a second objective (10) for focusing light into the sample (13) and for guiding light from the sample to a detecting system having a CCD. As a result, all scanning and video images fed through the laser scanner will be rotated by the image rotation system. It is noted that the use of a thick beam splitter can be seen in the element (5) disposed between the image rotating system and the lens (4)

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present

in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

B) With regard to the rejections of dependent claims under 35 USC 103(a), since applicant has not provided any specific arguments except referring to the arguments applied to the rejection of the base claims under 35 USC 102(b), see amendment (Paper No. 30, page 5); therefore, the dependent claims still rejected under 35 USC 103(a) for the same reasons as set forth in the previous Office action.

Conclusion

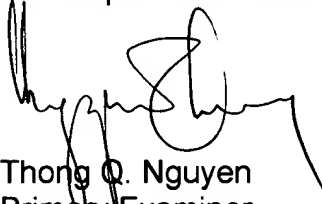
11. The references are cited as of interest in that each discloses a confocal/scanning microscope having an illuminating system having a pinhole, a detecting system having a pinhole, and a scanning system. It is noted that the references do not disclose the use of a rotatable optical system for image rotation.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

A handwritten signature in black ink, appearing to read 'Thong Q. Nguyen', is written over the printed name and title.

Thong Q. Nguyen
Primary Examiner
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July 14, 2003